

## REMARKS

Applicants have received and carefully reviewed the Office Action mailed October 7, 2003. Claims 105-123 are pending, having been newly added, and claims 1-104 have been cancelled without prejudice. Reconsideration and examination are respectfully requested.

With the above cancellations, all objections and rejections raised in the Office Action are rendered moot. To aid in advancing the application to issue, Applicants make the following comments with respect to U.S. Patent No. 6,148,230 to KenKnight.

In section 5 of the Office Action, on page 3, the Examiner stated:

Regarding claim 53, KenKnight shows an ICD comprising a housing having an electrically conductive surface on an outer surface of the housing; a lead assembly (20) coupled to the housing which does not directly contact the patient's heart or reside in the intrathoracic blood vessels; a capacitor system located within the housing and electrically coupled to the electrically conductive surface of the electrode and a battery subsystem electrically coupled to the capacitor system.

Similar remarks were made with respect to claim 79 on page 4 of the Office Action. It is believed that the above newly presented claims adequately distinguish KenKnight.

Applicants note that KenKnight illustrates not only the noted lead assembly 20, but also a second "lead assembly" in the form of a transvenous catheter 11. It appears that KenKnight consistently makes use of at least one electrode on the transvenous catheter 11 as a defibrillating electrode, which extends into the patient's heart.

With respect to claims 105, 117 and 121, the claims recite providing stimulus energy to a patient using electrodes both disposed exclusive of the patient's heart. This excludes, structurally, the use of an electrode extending into the patient's heart.

The rest of the Office Action does not appear to address the question of whether any of the cited references illustrate electrodes disposed as recited. Therefore, it is believed that further comment would not aid in advancing prosecution of the present claims.

In paragraph 16 of the Office Action, a number of the originally presented claims were provisionally rejected for obviousness type double patenting. It is believed that the above presented claims avoid this rejection. Applicants note that the claims in both noted cases have been amended such that none of the noted claims will remain pending. However, if the

Appl. No. 09/940,378

Amdt. dated February 6, 2004  
Reply to Office Action of October 7, 2003

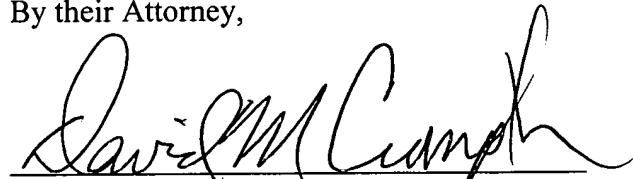
Examiner restates provisional rejections with respect to the newly presented claims, a terminal disclaimer can be filed in response.

Reconsideration and reexamination are respectfully requested. It is believed that each of claims 105-123 are allowable as presented. Issuance of a notice of allowance in due course is respectfully requested. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully submitted,

Gust H. Bardy et al.

By their Attorney,



David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349

Date: 2/6/04